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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,455	12/26/2001	Takayoshi Oyamada	0649-0814P	2939

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EXAMINER
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CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

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DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

10/025,455

Applicant(s)

OYAMADA ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communicati n appears on the cover sheet with th correspondence address --

## Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claiming of "mole %" in claims 1-5 in the absence of providing basis of the mole percentage renders the claimed indefinite.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP1004930 (EP'930). The EP'930

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discloses a photothermographic material containing non-photosensitive organic silver salt grain similar to that of the claimed invention. The grain having aspect ratio (AR) of at least 3; the average of the average grain diameter of 0.01 to 0.8  $\mu\text{m}$ ; the average of the needle ratio of said grain measure from the principal plane direction (Needle ratio =  $(\text{MxLNG})/(\text{WIDTH})$ ) is not less than 1.1 and less than 10 (page 3, and page 4). On page 5, paragraph [0052 to 0053], the silver behenate, silver arachidate, and/or silver stearate are preferred organic silver salt.

The present claimed invention is directed to a non-photosensitive organic silver salt having silver stearate content of 1 mole % or less ; silver arachidate content of 6 mole % or less; and silver behenate of 90 to 100 mole % or less. Therefore, the composition of the non-photosensitive organic silver grain of the claimed invention include any type of non-photosensitive organic silver salt including silver behenate which is preferred by the EP'930. Therefore, the claimed invention lacks novelty. Alternatively, it would have been obvious to form tabular organic silver salt grains containing the silver behenate, silver arachidate, and/or silver stearate in the EP'930 preferred embodiment with an expectation of achieving a material exhibiting high sensitivity, reduced image defects as well as fog. The limitation of claims 6-8 are related to the claiming of a material by a process. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is

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unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

6. Claims 1-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0962812 (EP'812).

EP'812 discloses a heat-developable material containing having fatty acid silver salt particle having the average equivalent-sphere diameter from 0.1 to 0.8  $\mu\text{m}$ ; the average ratio of long sides/short sides in main planes of 1 to 4; the aspect ratio of 2 to 30. The preferred aliphatic carboxylic acids include cerotic acid, lignoceric acid, behenic acid, erucic acid, arachidic acid, stearic acid, ...camphoric acid and mixture thereof. See page 5, paragraph [0035]. The preparation of silver behenate is shown on page 25-26, especially Table 2. The material having one or more layer is shown on page 21, paragraph [0187].

The present claimed invention is directed to a non-photosensitive organic silver salt having silver stearate content of 1 mole % or less ; silver arachidate content of 6 mole % or less; and silver behenate of 90 to 100 mole % or less. Therefore, the composition of the non-photosensitive organic silver grain of the claimed invention include any type of non-photosensitive organic silver salt including silver behenate which is preferred by the EP'812 such as shown in Table 2. Therefore, the claimed invention lacks novelty. Alternatively, it would have been obvious to form tabular organic silver salt grains containing the silver behenate, silver arachidate, and/or silver stearate in the EP'812 preferred embodiment with an expectation of achieving a material with excellent in antifogging ability, image stability, and light transmission properties. The limitation of

claims 6-8 is related to the claiming of a material by a process. "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

Cited of interest: Habayshi et al discloses silver salt of an organic acid including silver behenate having high purity that assures a production of excellent photographic material.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea   
November 30, 2002

  
Thorl Chea  
Primary Examiner  
Art Unit 1752